

1637 1634
#

PATENT
Customer No. 22,852
Attorney Docket No. 4121.0003-02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
SORGE et al.) Group Art Unit: 1634
Application No.: 08/529,767) Examiner: J. Fredman
Filed: September 18, 1995)
For: NOVEL POLYMERASE) ATTN: Jeffrey Fredman
COMPOSITIONS AND USES) Group Art Unit: 1634
THEREOF)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

SUPPLEMENTAL INFORMATION DISCLOSURE
STATEMENT UNDER 37 C.F.R. § 1.97(c)

Pursuant to 37 C.F.R. §§ 1.56 and 1.97(c), Applicants bring to the attention of the Examiner the documents listed on the attached form. This Information Disclosure Statement is being filed after the events recited in Section 1.97(b). To the undersigned's knowledge, there is no current Final Office Action, Notice of Allowance, or action that otherwise closes prosecution.¹ Under the provisions of 37 C.F.R.

¹ A Final Office Action was mailed February 24, 1997. The Supplemental Amendment that was filed December 10, 1997, confirms a telephone discussion in which Examiner Campbell stated that the finality of that Office Action was being withdrawn and that the application was in condition for allowance. Subsequent to December 10, 1997, no written communications in this case have been received from the United States Patent and Trademark Office ("USPTO"). The Third Supplemental Amendment that was filed January 28, 2003, reports a telephone call with Examiner Fredman, in which Examiner Fredman noted that claim 9 had depended from a canceled claim. In the Third Supplemental Amendment, claim 9 was canceled without prejudice or disclaimer.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP
1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

09/02/2003 AUCNDALF1 00000024 08529767

01 FC:1806

180.00 OP

§ 1.97(c), this Information Disclosure Statement is accompanied by a fee of \$180.00 as specified by Section 1.17(p).

Copies of the listed documents are enclosed. Several of the listed documents are copies of documents from the following four U.S. District Court litigations involving parent U.S. Patent No. 5,556,772 (the '772 patent):

Stratagene v. Invitrogen Corporation ("Invitrogen"), United States District Court for the District of Maryland, Southern Division, Civil Action No. DKC 01-3566 ("Case 1");

Stratagene v. Takara Holdings, Inc. and Takara Bio, Inc. ("Takara"), United States District Court for the District of Maryland, Southern Division, Civil Action No. WMN 02 CV 3603 ("Case 2");

Takara Bio, Inc. v. Stratagene, United States District Court for the Southern District of California, Case No. 03 CV 0742B AJB ("Case 3"); and

Takara Bio, Inc. v. Stratagene, United States District Court for the District of Maryland (Baltimore), Civil Action No. 1:03-cv-01871-WMN ("Case 4")².

In Case 1, the listed document is the Summons. In Case 2, the listed document is the Summons in a Civil Case. In Case 3, one of the listed documents is the Summons in a Civil Action. Although those three documents were submitted in the Information Disclosure Statement filed on May 27, 2003, they were not independently listed on the Form that accompanied that Statement. Applicants have listed those documents on the enclosed Form.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

² The listed documents also include a copy of the docket sheet for Case 4, which provides a list of pleadings filed in that case. If the USPTO requests copies of further documents, they will be provided to the extent permissible under the protective order.

In Case 3, Takara Bio requests correction of inventorship of the '772 patent to include Wayne Barnes as an inventor. Takara Bio's First Amended Complaint Under the Patent Law ("Takara Bio First Amended Complaint") includes allegations related to Takara Bio's request to correct inventorship of the '772 patent.

Case 3 also includes Takara Bio, Inc.'s Memorandum of Points and Authorities in Opposition to Stratagene's Motion to Dismiss, Stay or Transfer ("Takara Bio Opposition"). Exhibits 7 and 10 were omitted from the Takara Bio Opposition filed at the court. (See Declaration of John B. Pegram, page 2, items 10 and 13.) The Takara Bio Opposition filed at the court included Exhibit 5. The undersigned was informed by Stratagene's litigation counsel Scott Chambers that because Exhibit 5 is marked confidential it should not be submitted to the USPTO. Thus, the enclosed copy of the Takara Bio Opposition does not include Exhibit 5.

Case 3 was transferred to the District Court of Maryland, now Case 4. A copy of the Order Granting Defendant's Motion to Transfer is enclosed. The U.S. District Court District of Maryland (Baltimore) Civil Docket for Case #: 1:03-cv-01871-WMN indicates that the Takara Bio Complaint Under the Patent Law, Takara Bio First Amended Complaint, Stratagene's Notice of Motion to Dismiss, Transfer or Stay Action, Takara Bio Opposition, Defendant Stratagene's Reply in Support of Motion to Transfer, Dismiss or Stay, and other documents were transferred from Case 3 to Case 4.

In Case 4, Stratagene submitted an Answer to Plaintiff Takara Bio, Inc.'s First Amended Complaint ("Stratagene Answer"). The Stratagene Answer includes Stratagene's response to Takara's allegations in Takara's First Amended Complaint.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Some of the listed documents relate to reexamination of parent U.S. Patent No. 5,556,772.

This submission does not represent that a search has been made or that no better art exists and does not constitute an admission that the listed documents are material or constitute "prior art." If the Examiner applies the documents as prior art against any claim in the application and Applicants determine that the cited documents do not constitute "prior art" under United States law, Applicants reserve the right to present to the office the relevant facts and law regarding the appropriate status of the documents.

Applicants further reserve the right to take appropriate action to establish the patentability of the claimed invention over the listed documents, should the documents be applied against the claims of the present application.

If there is any fee due in connection with the filing of this Statement, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 28, 2003

By: 

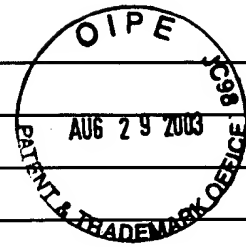
M. Paul Barker
Reg. No. 32,013

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

INFORMATION DISCLOSURE CITATION

Atty. Docket No.	04121.0003-02000	Appln. No.	08/529,767
Applicant	Joseph SORGE et al.		
Filing Date	September 18, 1995	Group:	1634



U.S. PATENT DOCUMENTS						
Examiner Initial*	Document Number	Issue Date	Name	Class	Sub Class	Filing Date If Appropriate

FOREIGN PATENT DOCUMENTS						
Document Number	Publication Date	Country	Class	Sub Class	Translation Yes or No	

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)	

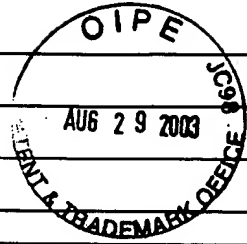
OTHER DOCUMENTS (from Stratagene v. Invitrogen Corp.) District of Maryland (Greenbelt), Case #: 8:01-cv-03566-DKC	
	Summons ✓

OTHER DOCUMENTS (Stratagene v. Takara Holdings, Inc., et al.) District of Maryland (Baltimore), Case #: 1:02-cv-03603-WMN	
	Summons in a Civil Case ✓

OTHER DOCUMENTS (Takara Bio Inc. v. Stratagene, et al.,) Southern District of California (San Diego), Case #: 03-CV-742	
	Summons in a Civil Action ✓
	Plaintiff Takara Bio, Inc.'s First Amended Complaint Under the Patent Law ✓
	Notice of Motion to Dismiss, Transfer or Stay Action, with Exhibits A-V ✓
	Takara Bio, Inc.'s Memorandum of Points and Authorities in Opposition to Stratagene's Motion to Dismiss, Stay or Transfer, with Declaration of John B. Pegram and Exhibits 1-4, 6, 8, 9, and 11-32.
	Defendant Stratagene's Reply in Support of Motion to Transfer, Dismiss or Stay, with Exhibits A and B ✓
	Order Granting Defendant's Motion to Transfer [Docket No. 10] ✓

INFORMATION DISCLOSURE CITATION

Atty. Docket No.	04121.0003-02000	Appln. No.	08/529,767
Applicant	Joseph SORGE et al.		
Filing Date	September 18, 1995	Group:	1634



**OTHER DOCUMENTS (Takara Bio Inc. v. Stratagene, et al.)
District of Maryland (Baltimore), Case #: 1:03-cv-01871-WMN**

	U.S. District Court, District of Maryland (Baltimore), Civil Docket for Case #: 1:03-cv-01871-WMN
	Stratagene's Answer to Plaintiff Takara Bio, Inc.'s First Amended Complaint Under the Patent Law

OTHER DOCUMENTS (from U.S. Patent No. 5,556,772)

✓	Request by Takara Bio Inc. for Leave to Participate in this Reexamination as a Partial Assignee (Co-owner) and other Takara Bio Inc. Submissions with Exhibits 1-7 and A-L.
✓	Letter Concerning Request by Takara Bio Inc. for Leave to Participate in this Reexamination as a Partial Assignee (Co-owner) and other Takara Bio Inc. Submissions, with Exhibits 1 and 2.
✓	Letter Submitting Copy of Request by Takara Bio Inc. for Leave to Participate in this Reexamination as a Partial Assignee (Co-owner) and other Takara Bio Inc. Submissions.
✓	Reply to Owner's Statement Under 37 C.F.R. § 1.535, Transmittal Form, and Certificate of Service.

Examiner	Date Considered
*Examiner: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.	
Form PTO 1449	Patent and Trademark Office - U.S. Department of Commerce